

## **REMARKS**

### **A. Introduction**

Claims 1, 2, 11, 16 and 18 were presented for examination.

Claims 1, 2, 11, 16 and 18 were rejected.

Claim 11 was amended.

### **B. Claims 4-15 and 17 Objected Under 37 C.F.R. 1.75**

Examiner objected to Claims 4-15 and 17 as being of improper dependent form. Respectfully, Applicants already fully addressed these objections in their "Response to Office Action of March 7, 2006," submitted on June 5, 2006 and incorporated herein by reference, by canceling Claims 3-10, 12-15, and 17. Applicants also amended Claim 11 for clarification. With respect to these claims, Applicants respectfully request that Examiner withdraw her objections.

### **C. Claims 1-18 Rejected Under 35 U.S.C. § 103**

Examiner rejected Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2003/0211062 to Laden et al (Laden) in view of U.S. Patent No. 5,997,889 to Durr et al (Durr). Further, Examiner rejected Claim 18 under 35 U.S.C. § 103(a) as being unpatentable over KR 149428 to Lee et al. (KR). Applicants respectfully disagree.

#### **1. The Laden Reference**

Examiner cites Laden as the primary reference in rejecting Claims 1-17 and as the basis for supporting her finding of obviousness of the present invention. Respectfully, Examiner failed to satisfy her burden of maintaining her obviousness conclusion.

Laden fails to teach the limitation of "a mixture of at least 50% by weight of total composition of processed Dead Sea mineral particles" or that the processed Dead Sea

mineral particles are “suspended in a continuous all-natural carrier medium, consisting of an oil, and at least one essential oil,” as recited in Claim 1. Laden also fails to teach the limitation of a “continuous all-natural carrier medium comprises at least one oil selected from the group consisting of palm oil, soybean oil, olive oil, jojoba oil, beeswax, jojoba wax, cashew husk oil ethoxylate, coconut oil and Vitamin E oil,” as recited in Claim 2. Further, Laden also fails to disclose the limitation of a “blend of essential oils selected from the group consisting of lavender, rosewood, chamomile and calendula,” as recited in amended Claim 11. Finally, nowhere in Laden can be found the limitations of “100% of said processed Dead Sea mineral particles consisting of granularity of less than about 10 mesh and less than about 1.0 mm size granularity,” as recited in Claim 16, or “100% of said processed Dead Sea minerals consisting of an ultra-fine uniform specific granularity of less than 1.0 mm size granularity,” as recited in Claim 18.

With respect to particle size, Examiner points to references to Dead Sea salts used as abrasive material in Examples 1 and 8 contending that “the abrasive particles of Laden meet the claimed size range i.e., 100% particles consisting of an ultra-fine uniform granularity of less than 1.0 mm granularity.” (Page 5). Applicants disagree. Examiner further stated, “applicants agree that Laden and KR teach claimed large amounts of Dead Sea salts.” (Page 7). This is not true. Laden discloses that the Dead Sea salts used were commercially obtained from Dead Sea Works, Ltd. in Israel and discloses its “typical” composition. [0035]. Interestingly, this is the same source from which Applicants obtain their native Dead Sea minerals in order to practice their invention. (*See* Declaration of Morris Samelson; *see also* Declaration of Johnathan Scharff). Yet, the typical composition used in the present invention is different from Laden’s description of the

typical composition. Therefore, the “typical” composition for the Dead Sea salts described in Laden is either inaccurate or its Dead Sea minerals with that type of composition do not exist. In either case, Laden’s disclosure, nonetheless, fails to teach the claimed granularity size as Dead Sea Works, Ltd., only offers Dead Sea minerals in two (2) standard grades: a course grade with greater than 90% between 5 and 10 mesh and greater than 90% between 1.7 mm and 4.0 mm size granularity; and a finer grade having 90% less than 10 mesh and 90% less than 1.7 mm. (See emails, dated January 11, 2007, between Morris Samelson, a named inventor of the present invention, and Ms. Mazal Joseph, Head of Marketing Division, Chemical Production of Dead Sea Works Ltd. indicating that the “typical analysis attached hereto is the only spec we can conform to” and “Typical Analysis of Dead Sea Bath Salts, January 2004,” giving the two granularity grades available and provided by Dead Sea Works, Ltd. attached thereto; *see also* Specification, Page 13, lines 8-13). The “typical analysis” of the Dead Sea bath salts can be confirmed by visiting Dead Sea Works Ltd.’s website, [www.dsw.co.il](http://www.dsw.co.il). Attached is a true and correct copy of a webpage taken from this website indicating the typical composition of Dead Sea salts made available by Dead Sea Works, Ltd. This is irrefutable evidence that Laden does not and cannot teach the granularity size of the present invention, as Examiner erroneously contends.

Neither Laden nor KR teaches the use of an “all natural carrier medium” as each is replete with “unnatural” and artificial ingredients. Laden contains, for example, “silicone oil,” and “polyhydric alcohol” (i.e., polyol), and preservative, ingredients that are synthetically produced. KR also uses synthetic and unnatural ingredients and preservatives. (see Table 1, Page 4). In contrast, the present invention contains all

natural ingredients.

The problem addressed in and solved by the present invention was how to significantly increase the concentration of Dead Sea salts in a cosmetic composition in order that the consumer would be able to take advantage of the beneficial properties of the Dead Sea. Until the present invention, concentrations of Dead Sea salts in cosmetic compositions were limited to a few percent of the weight of the composition due to their unique properties.

Applicants solved this problem developing a method of fractionalizing (i.e., processing) the Dead Sea minerals to a particular granularity size (i.e., less than 1.0 mm) under controlled conditions. The resulting ultra-fine mineral compound could remain in suspension without the use of artificial ingredients. Such small uniformed granularity sizes of Dead Sea minerals cannot be achieved except under the conditions of the present invention. This is the *only* way that the Dead Sea salts will stay in suspension in an all-natural carrier medium. Any other method of maintaining unprocessed Dead Sea salts (i.e., unprocessed as done in the present invention) would necessarily require the addition of non-natural "free flowing" or "anti-caking" agents that would alter the natural composition. (See Declaration of Morris Samelson; *see also* Declaration of Johnathan Scharff). As Applicants had to process 100% of the native Dead Sea Salts purchased from the Dead Sea Works, Ltd. in order to achieve granularity sizes of less than 1.0 mm, it logically follows that without processing (and in the manner done by the present invention), Laden could not have achieved the claimed particle size for Dead Sea salts. Examiner failed to show otherwise.

As Laden does not teach the claimed granularity size of the Dead Sea minerals of

the present invention, even in combination with Durr, these references would not be able to solve the problem addressed by the present invention. It would not be obvious to combine Laden with Durr as this combination would not result in the present invention. Consequently, there is no motivation to combine these references to come up with the present invention. Further, neither Laden nor KR, either alone or in combination, would solve the problem addressed by the present invention because neither reference would be able to sustain the Dead Sea salts in their composition with all natural ingredients. Examiner is respectfully requested to withdraw her rejection of Claims 1-18.

2. The KR Reference

KR is to be strictly construed and restricted to what is clearly and definitely disclosed therein, not that which may be made out of it. *General Tire & Rubber Co. v. Watson*, 184 F. Supp. 344, 125 U.S.P.Q. 628 (D.C.D.C. 1960); *General Tire & Rubber Co. v. Firestone Tire & Rubber Co.*, 349 F. Supp. 345, 174 U.S.P.Q. 427 (N.D. Ohio 1972), *aff'd in part, rev'd in part and vacated in part on other grounds*, 489 F.2d 1105, 180 U.S.P.Q. 98 (6th Cir. 1973), *cert. denied*, 417 U.S. 932, 182 U.S.P.Q. 1 (1974). Even considering its specification, KR fails to teach the limitation of "a mixture of at least 50% by weight of total composition of processed Dead Sea mineral particles suspended in a continuous all-natural carrier medium, consisting of an oil, and at least one essential oil," as recited in Independent Claim 1.

Nor does KR disclose any definite degree of fractionalization, or processing, that occurs with the Dead Sea minerals prior to their use in the composition. Even taking the entire specification into consideration, KR still fails entirely to provide adequate disclosures regarding either processed Dead Sea minerals alone or a composition with processed Dead Sea minerals. KR, whether alone or in combination with the other cited

references simply cannot support a finding of obviousness. Examiner has not shown otherwise.

Examiner argues that it would have been obvious for one of ordinary skill in the art to choose particle sizes of Dead Sea salts between 0.01 mm and 5.0 mm as disclosed in KR and still expect to provide an effective skin scrubbing composition that is pleasant to touch and not irritating to the skin. (Page 6). Applicants disagree.

As noted above, it is clear that Laden does not disclose the claimed granularity of the present invention. KR also places full emphasis on bamboo salts and merely pays lip service to Dead Sea salts. Further, the specific granularity of the present invention avoids the disadvantages of other compositions, such as those found in Laden and KR, that contain Dead Sea salts but in higher granularity sizes. In manufacturing, the inclusion of particles larger than 1.0 mm causes uneven dispersion of the particles in a formulation. Additionally, by way of example, the particle sizes as used by KR limit the way that the product may be packaged and would require mixing by the consumer prior to use. (*See* Declaration of Morris Samelson; *see also* Declaration of Johnathan Scharff). In contrast, the present invention allows for even dispersion throughout the composition and is not limited to being packaged in, for example, jars, but can be packaged in plastic tubes with small apertures for ultimate convenience and portability to the customer. *Id.* This composition does not require mixing prior to use and will not scratch or cause discomfort to the consumer's skin. *Id.*

In discussing granularity size, Examiner points to Laden that warns that large particles (i.e., greater than 1.0 mm) would "scratch and irritate the skin." [0033]. But, as noted above, Examiner also argued that granularity sizes of up to 5.0 mm would not be

irritating to the skin. Examiner's inconsistent positions only further supports that these two references lack the suggestion or motivation to combine together to come up with the present invention.

Examiner states that nowhere in the present specification is "process" defined as "100% will have less than 10 mesh and 100% will have less than 1.0 mm size granularity. (Page 7). Applicants disagree. The specification clearly details the fractionalization, and thus the "processing" of the native Dead Sea minerals, stating that the "processing step for any version of the minerals ensures that 100% will have less than 10 mesh and 100% will have less than 1.0 mm size granularity." (See Page 14, line 6). This limitation is not taught by any of the cited references.

3. Examiner errs in dismissing the Declaration of Joseph P. Ettari

Examiner dismissed the Declaration of Joseph P. Ettari. Examiner glossed over the almost 20 years of experience that Mr. Ettari has in the cosmetic industry. Indeed, Mr. Ettari is the epitome of a person having ordinary skill in the art, i.e., in this case, the cosmetic industry. Mr. Ettari was not just an employee, but held and continues to hold a management position overseeing and being intimately involved in the development of products containing Dead Sea minerals. Mr. Ettari's declaration emphasized the long felt but unsolved need in the cosmetic industry for a composition containing Dead Sea minerals of such a particular specific granularity size that significantly high concentrations of Dead Sea minerals, which would be uniform throughout the composition, could be added to form an esthetically acceptable cosmetic composition. Mr. Ettari stated that he had not seen this type of product in the cosmetic industry, indicative of the failure of others to be able to develop such a product. If there was such

a product, all logic dictates that the developer of such a product would have had some run in with Mr. Ettari's employer. If anyone had known of a product such as the present invention, it would have been Mr. Ettari. His declaration exemplifies the ordinary knowledge of one skilled in the art. Examiner improperly replaces her subjective knowledge over and above the objective knowledge of an experienced and qualified cosmetic chemist whose employer is one of the world's leading manufacturers and marketer of quality skin care products. Respectfully, Examiner erred in dismissing this declaration as "unpersuasive."

4. No suggestion to combine references can be found in the cited references.

As explained above, the three references—KR, Laden, and Durr—which are relied upon by Examiner are in no way combinable to produce the present invention. Even if these references arguably disclose various elements of the present invention, this disclosure is not enough to sustain a finding of obviousness. The mere fact that cited references can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. *In re Imperato*, 486 F.2d 585, 587 (C.C.P.A. 1973); *In re Bergel*, 48 C.C.P.A. 1102, 292 F.2d 955 (1961). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. *Ecolochem Inc.*, 227 F.3d at 1371-72.

Respectfully, Examiner's failure to show any teaching, suggestion, or motivation that would have led a skilled artisan at the time of the invention to the claimed combination as a whole gives rise to an inference that Examiner used hindsight to



conclude the invention was obvious. This was clearly stated in *In re Rouffett*:

Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [Applicant's] invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight. This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. Lacking a motivation to combine references, the Board did not show a proper *prima facie* case of obviousness. This court reverses the rejection over the combination of [the three cited references]. *In re Rouffett*, 149 F.3d 1350, 1358, 47 U.S.P.Q. 2d 1453 (Fed. Cir. 1998) (internal citation omitted).

However, even combined, these references are still inadequate to solve the problems addressed by the present invention. It is respectfully submitted that Applicants' claims, as amended, overcome all of Examiner's objections and rejections thereto. Examiner is respectfully requested to withdraw her objections and rejections.

#### CONCLUSION

In view of the above, Applicants submit that Claims 1, 2, 11, 16, and 18 are in condition for allowance. Applicants respectfully request reconsideration and withdrawal of the rejections and objections. Allowance of Claims 1, 2, 11, 16, and 18 at an early date is solicited. If Examiner still finds impediments to allow Claims 1, 2, 11, 16, and 18 and, in the opinion of the Examiner, a telephone conference between the undersigned and Examiner would help remove such impediments, the undersigned respectfully requests such a telephone conference.

Respectfully submitted,

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